

**REMARKS**

Applicants appreciate the consideration of the present application afforded by the Examiner. Claims 33-51 were pending prior to the Office Action. Claims 34, 38-39, 41-42, 44-45, 47-48, and 50 have been canceled and claims 52-56 have been added through this Reply. Therefore, claims 33, 35-37, 40, 43, 46, 49, and 51-56 are pending. Claims 33, 37, 43, and 49 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

***Claim Rejections - 35 U.S.C. §101 and § 112, first paragraph***

Claims 35 and 36 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter, and are additionally rejected under 35 U.S.C. § 112, first paragraph. Applicants respectfully traverse the rejections.

In the Office Action, the Examiner alleges that the claimed invention is not supported by either a specific and substantial asserted utility or a well-established utility, based upon the rationale that “[c]laims 35 and 36, are directed a [sic] portable communication terminal, however the claims are dependent upon in claim 33, which is directed to a data converter.” The Examiner further alleges that “one skilled in the art clearly would not know how to use the claimed invention.” *See Office Action, p. 2, item 2.* Applicants respectfully disagree.

Claims 35 and 36 clearly recite a portable communication terminal transmitting data to and from the data converter recited in claim 33. In other words, the portable communication terminal of claims 35 and 36, including the recited features, would at least have to be *capable* of effecting the transmission of data to and from a data converter including the features recited therein. One of ordinary skill in the art would be apprised of the technology required to effect communication between a data converter such as that described by claim 33 and a portable communication terminal as described in claims 35 and 36.

Applicants further submit that the Examiner has not satisfied his burden with regard to the written description requirement of the MPEP. Applicants direct the Examiner to MPEP § 2163.04, which states:

The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. [*MPEP* § 2163.04, emphasis added].

Applicants submit that the Examiner has not satisfied his burden of presenting a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. See *MPEP* § 2163.04 (I)(B). As discussed above, Applicants maintain that one of ordinary skill in the art would recognize, based on the disclosure as filed, support for the invention as recited in the claims.

Accordingly, Applicants submit that the claims are in fact supported by the written disclosure and respectfully request that the rejection of claims 35 and 36 under § 101 and § 112, 1<sup>st</sup> paragraph be withdrawn.

Claims 43-51 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicants respectfully traverse the rejection.

Claim 43, pre-amendment, recited “a reception portion receiving, from said data converter, at least one of data in said first second data format and said file in said second data format.” (Emphasis added.) This appears to be a typographical error in the originally presented claims. Through this reply Applicants have amended claim 43 to change “first second data format” to read “first data format.” Although the typographical error may potentially have caused confusion regarding issues of definiteness and clarity under § 112, second paragraph, Applicants respectfully disagree with the examiner’s characterization of the claim as lacking enablement under § 112, first paragraph. Regardless, the current amendment renders the issue moot.

Similarly, the Amendment to claim 49 renders the issue moot.

In view of the amendment to the claims, Applicants respectfully request that the §112, first paragraph rejection of claims 43-51 be withdrawn.

### ***Double Patenting***

In the Office Action, the Examiner indicated that should claims 37-42 be found allowable, claims 43-48 will be objected to under 37 CFR 1.75 as being substantial duplicate claims. Applicants respectfully submit that the current amendments to the claims obviate the potential for double patenting.

### ***Claim Rejections - 35 U.S.C. §102***

Claims 33-35, 37, 38, 40, 41, 43, 44 and 46-51 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Nishimura, U.S. Patent Publication 2002/0051181 ("Nishimura"). Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation and traverse the rejection.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. §102, the cited reference must teach or suggest each and every element in the claims. *See M.P.E.P. §2131; M.P.E.P. §706.02*. Accordingly, if the cited reference fails to teach or suggest one or more claimed elements, the rejection is improper and must be withdrawn.

Independent **claim 33** recites

A data converter comprising:

a reception portion receiving electronic mail;

a conversion portion converting data included in a file attached to said electronic mail, said conversion portion including a first conversion portion converting said data included in said file attached to said electronic mail into data represented in a first predetermined data format, and a second conversion portion converting said data included in said file attached to said electronic mail into data represented in a second predetermined data format;

a memory portion storing said data generated through conversion and represented in said first data format and said data generated through conversion and represented in said second data format; and

a transmission portion transmitting said data output from said first and second conversion portions,

wherein said data represented in said first data format includes data representing a list of either said converted file or said data generated through conversion,

said data represented in said second data format is an image generated by conversion of said file, and

said memory portion stores said list and said image in association with each other.

Nishimura discloses a system that converts a file attached to an email such that the file may be displayed in a reception terminal. *See Nishimura, abstract.* Nishimura discloses determining whether the reception terminal is capable of handling email attachments in a particular format. Then the attachment data is converted to a particular format that the reception terminal has been determined to be capable of handling. Nishimura discloses such file formats as GIF, PNG, and JPEG formats. *See e.g., paragraphs 45, 49, and 148-152.*

However, Nishimura fails to disclose all of the features of claim 33, wherein data represented in a first data format includes data representing a list of either the converted file or the data generated through the conversion, and that data represented in a second data format is an image generated by the conversion of the file. Furthermore, Nishimura fails to disclose a transmitting portion transmitting both the data output from a first conversion portion and the data output from a second conversion portion, or that a memory portion stores the list and the image in association with each other.

In the Office Action, the Examiner cites paragraphs [0116]-[0121] of Nishimura as allegedly describing these features. *See Office Action, p. 5, ¶ 2.* Nishimura discloses a list display area 241 which displays a list of addresses in a pull-down menu. *See ¶ [0017].* These addresses represent the email addresses of the potential recipients of the mail message. Clearly, this list does not obviate the list of the converted file or the data generated through the conversion, as claimed. Furthermore, Figure 9 of Nishimura shows a “profile setting” dialog box 250 which includes setting items with respective setting values in window 251. Although one of these setting items is referred to as a “list of files sent,” there is no disclosure that this “list” represents the data generated through the conversion. Additionally, there is neither any disclosure that this list is transmitted in any way, nor that this list is stored in association with an image generated by conversion of said file, as claimed.

Therefore, at least because Nishimura fails to teach or suggest each and every claimed element, independent claim 33 is distinguishable from the prior art. Independent claim 49 recites at least features comparable to the features discussed above with respect to claim 33 and is distinguishable from the prior art at least for the reasoning applied to claim 33. Dependent claims 35, 36, and 51-56 are also distinguishable from the prior art, at least due to their dependence from independent claims 33 and 49, directly or indirectly.

Independent **claim 37** recites:

A method for a portable communication terminal receiving, from a data converter, each file converted in first and second data formats, said data converter including a function receiving electronic mail, a function converting data included in said electronic mail into said first and second data formats, and a function transmitting said converted data, the method comprising:

receiving at the portable communication terminal, from said data converter, at least one of files in said first and second data formats;

selecting at least one of files received by said reception portion; and

notifying said data converter of which file has been selected,

wherein said one of said files in said first and second data formats is data for reducing and displaying unconverted data, wherein said data for reducing and displaying unconverted data is raster data, and wherein data received after said data converter is notified of which file has been selected is vector data.

The Examiner indicates in the Office Action that he rejects claim 37 under the same rationale presented with respect to claim 33. *See Office Action, p. 5, ¶ 4.* However, Applicants note that claim 37 presents features different in scope from that of claim 33. Accordingly, the Examiner has not presented a rejection that satisfies his burden of providing a *prima facie* case of anticipation by expressly detailing how the applied prior art discloses each of the elements of the claim. For at least this reason, the rejection of claim 37 under 35 U.S.C. § 102(b) should be withdrawn.

Additionally, Applicants respectfully submit that Nishimura fails to disclose the steps recited in claim 37, specifically with respect to receiving at the portable communication terminal, from the data converter, at least one of files in a first and second data format; selecting at least one of files received by the reception portion; and notifying the data converter of which file was selected. Furthermore, Nishimura fails to disclose that one of the files is raster data for reducing

and displaying unconverted data, and that data received after the data converter is notified of which file has been selected is vector data.

Therefore, at least because Nishimura fails to teach or suggest each and every claimed element, independent claim 37 is distinguishable from the prior art. Independent claim 43 recites at least features comparable to the features discussed above with respect to claim 37, and is distinguishable from the prior art at least for the reasoning applied to claim 33. Dependent claims 40 and 46 are also distinguishable from the prior art, at least due to their dependence from independent claims 37 and 43.

Based on the foregoing, Applicant respectfully requests that the rejection of claims 33-35, 37, 38, 40, 41, 43, 44 and 46-51 under 35 U.S.C. § 102(b) be withdrawn.

***Claim Rejections - 35 U.S.C. §103(a)***

Claims 36, 39, and 45 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nishimura as applied to claims 35, 38 and 44, further in view of Doll, U.S. Patent 6,266,400 ("Doll"). Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and traverse the rejection.

For a 35 U.S.C. § 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142*. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

As discussed above, Nishimura fails to teach or suggest all of the features of independent claims 33, 37, 43, and 49. Doll has not been, and indeed cannot be, relied upon to correct at least this deficiency of Nishimura. Dependent claims 36, 39, and 45 are distinguishable from the prior art at least due to their dependency from claims 33, 37, and 43, directly or indirectly.

Therefore, Applicants submit that claims 36, 39, and 45 are patentable over Nishimura in view of Doll and respectfully request that the rejection of the claims under §103(a) be withdrawn.

*New Claims*

New claims 52-56 have been added through this Amendment, and are considered to be in condition for allowance at least due to their dependence upon claims 33 and 49. No new matter has been entered.

**CONCLUSION**

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice of same is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John R. Sanders Reg. No. 60,166 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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